

REMARKS

The Examiner rejected claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 under 35 U.S.C. §103(a) as being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and in further view of Shirley *et al.* (USPN 5692206).

The Examiner rejected claims 2, 8, and 14 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

The Examiner rejected claims 4-5, 10-11, 16-17, and 20 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of Grubb *et al.* (USPN 5272623).

Applicants respectfully traverse the §103 rejections with the following arguments.

35 U.S.C. §103

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The Examiner rejected claims 2, 8, and 14 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

The Examiner rejected claims 4-5, 10-11, 16-17, and 20 under 35 U.S.C. §103(a) as being unpatentable over Luchs in view of Hoyt and Shirley and in further view of Grubb *et al.* (USPN 5272623).

Applicants respectfully contend that claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt *et al.* and in further view of Shirley. In the prior office action, Applicants presented four examples of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt *et al.* and in further view of Shirley. In the present office action, the Examiner presented response to each of said four examples. Next, Applicants will present arguments directed to overcoming the Examiner's responses to said four examples. Additionally, Applicants will present a fifth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt *et al.* and in further view of Shirley.

First Example

As a first example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of

Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "one or more model agreements". The Examiner alleges: "Luchs teaches the use of common application forms (col 2, ln 26-61; compare with '*one or more model agreements;*')".

In response, Applicants note that Luchs recites in col. 4, lines 3-19: "This contract is substantially simplified over existing insurance contracts and is created to be custom tailored for the particular client and risk involved.... This custom tailoring is achieved by a compiling and editing function in the central processor in which data representing predetermined form paragraphs are stored, and those paragraphs which are applicable to the particular insurance contract requested are selected. ...These separate and complete paragraphs are then sequenced by the processor for printing in the desired order to yield an insurance contract which is tailored to the client and the risk" (emphasis added). To apply the preceding teaching to claims 1, 7, and 13, note that an agreement is a contract (see any dictionary). Applicants respectfully contend that Luchs's system does not include model agreements (i.e., model contracts) as required by claims 1, 7, and 13, but instead includes a database of stored paragraphs, such that an insurance agreement (i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs.

In further illustration of the first example, consider the following analogy. First, consider a room ("Room A") that stores computer parts (microprocessors, hard drives, power supplies, monitors, etc) such that computers may be synthesized from a selection of computer parts from Room A. Next, consider another room ("Room B") that stores model computers. By application to claims 1, 7, and 13, Shirley teaches Room A which stores paragraphs from which agreements

(i.e., contracts) may be synthesized after a selection of paragraphs from Room A. In contrast, claims 1, 7, and 13 teach Room B which stores the model agreements themselves.

In "Response to Arguments" in the present office action, the Examiner argues: "Applicant argues (pg 8-9, Amendment A) that the prior art of record does not teach or suggest "one or more model agreements". However, Applicant admits that Luchs does teach predetermined paragraphs used to create insurance contracts, or agreements (pg 9, Amend. A). Luchs does not preclude the use of said predetermined paragraphs as model agreements. It was known at the time of the invention that agreements and contracts appeared in various sizes and lengths. It is not unreasonable to assert that an entire agreement or contract may have been comprised in one paragraph, such as the paragraphs taught by Luchs. Since Luchs' paragraphs are predetermined, this gives a user the opportunity to use the paragraphs as models on which to base a contract analogy of a room full of computer parts versus a room of model computers. However, computers appear in every shape and size. Some computers require additional peripherals or devices to function properly, and thus would require the construction of the various parts in the computer part room in order to obtain a proper computer to present in the model computer room. On the other hand, some computers don't require additional parts because the device is itself a computer independent of any additional parts attached. That computer remains the same in both the parts room and model room. For example, a calculator may be stored in the storage room along with associated parts (a device for projecting the display, additional power supply, link cable, etc.). The calculator may be shown in the model room with the extra parts attached, or by itself. Either way, the calculator is still a computer. This is keeping with the Office's argument that a paragraph taught by Luchs may be a model contract itself; the opportunity to add additional

paragraphs does not negate the fact that a single paragraph may constitute an entire contract.”

In response to the preceding argument by the Examiner in “Response to Arguments”, Applicants respectfully contend Luchs always refers to “paragraphs” in the plural form when disclosing the grouping of paragraphs to form an insurance contract. See, e.g., Luchs, col. 4, lines 15-19: “These separate and complete paragraphs are then sequenced by the processor for printing in the desired order to yield an insurance contract which is tailored to the client and the risk.” Luchs never refers to an insurance contract as consisting of only one of said paragraphs. Thus, Applicants respectfully suggest that the Examiner’s assumption that one of Luch’s stored paragraphs could be a complete contract is unsupported speculation.

Therefore, Applicants reiterate that Luchs’s system does not include model agreements as required by claims 1, 7, and 13.

Second Example

As a second example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: “a document assembler for selecting and merging all or part of said one or more model agreements into a contract in response to said client request” (claim 1); “assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool” (claim 7); and “third program instruction means for assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool” (claim 13). As explained *supra*, Luchs selects and merges individual paragraphs to form an insurance contract, while claims 1, 7, and 13 recite

selection and merging of model agreements to form a contract.

In "Response to Arguments" in the present office action, the Examiner argues: "Applicant argues (pg 9-10, Amendment A) that. Luchs' teaching of selecting and merging individual paragraphs to form an insurance contract (i.e. agreement) does not teach or suggest the claimed selecting and merging of model agreements. However, as argued above, Luchs' paragraphs may be model agreements themselves. In such a case, the selecting and merging of individual paragraphs would read on the selecting and merging of model agreements as claimed".

In response to the preceding argument by the Examiner in "Response to Arguments", Applicants reiterate that an individual paragraph is not a contract, as explained *supra* in conjunction with the First Example.

Third Example

As a third example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "a repository for storing said contract and said tracking data and for responding to said client inquiry" (claim 1); "storing said contract and said tracking data in a repository" (claim 7); and "fifth program instruction means for storing said contract and said tracking data in a repository" (claim 13). The Examiner alleges: "Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with "*a repository... inquiry.*"")."

In response, Applicants respectfully contend that col. 4, lines 28-31 of Luchs teaches: "the information included in the original application is electronically stored", which is not what

claims 1, 7, and 13 require. Luchs teaches storing "information included in the original application". In contrast, claim 1 requires storing the **contract and said tracking data**. In fact, Luchs does not even disclose tracking data, as admitted by the Examiner. Thus, the Examiner's argument relating the preceding feature of claims 1, 7, and 13 in the third example is not persuasive.

In "Response to Arguments" in the present office action, the Examiner argues: "Applicant argues (pg 10, Amendment A) the prior art of record does not teach or suggest "a repository for storing said contract and said tracking data and for responding to the said client query". The Office admits that Luchs does not explicitly teach tracking data and the storage of that tracking data. The Office contends that Luchs does teach the storage of the contract as per Luchs teaching of "the information included in the original application is electronically stored and displayed". Hoyt, however, teaches keeping track of information associated with contracts, such as approvals, as per the rejection of claim 1 above. Hoyt teaches such information being stored in repositories (col 8, ln 33-42). When combined with Luchs it would have been obvious to one of ordinary skill in the art at the time of the invention to include a repository in which to store the tracking information associated with the contract. Not storing the information in memory would have defeated the purpose of tracking the status of the contract since the contract itself would have had to be looked at every time a status query was made."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicants respectfully contend that it is not obvious to modify Luchs to include a repository in which to store the tracking information associated with the contract, because Luchs is concerned only with processing insurance applications and generating insurance contracts therefrom. Luchs

is not concerned with tracking information associated with the generated insurance contracts. Therefore, modifying Luchs as suggested by the Examiner is not relevant to the purpose of Luchs' invention and is thus not obvious.

Fourth Example

As a fourth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Applicants respectfully maintain that the Examiner's argument for modifying Luch's invention with Hoyt (for approvals) and Shirley (for key date reminders) is not persuasive. The Examiner argues: "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Luchs' invention to include means for tracking the approval status and important dates associated with a contract, including storing the tracking information in a repository. Such a modification would have given an agent generating a contract more flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the agent to track the document's status and associated dates would have alleviated a communication burden if negotiating was necessary. Storing the tracking information would have allowed a user to check the contract's status with requiring the contract itself to check"

In response, Applicants observe the following teaching in col. 2, lines 14-18 of Shirley: "The present invention also provides auxiliary documents which are related to the negotiated contract documents such as payment schedules, due date schedules, termination dates, and other tasks which accompany the execution of a contract". A review of the preceding dates disclosed in Shirley reveals that said dates disclosed in Shirley relate essentially to events which will occur

after the contract has been generated and not to events that support the contract generation process. However, Luch's invention is concerned essentially with the contract generating process and not with events occurring after the contract has been generated. Therefore, Shirley's dates are not relevant to Luch's invention. Accordingly, it would not be obvious to a person of ordinary skill in the art to modify Luch's invention by adding Shirley's means for tracking dates.

In "Response to Arguments" in the present office action, the Examiner argues: "Applicant argues (pg 10-11, Amendment A) the motivation for combining the prior art of record because Shirley's use of dates essentially relates to events that will occur after the contract has been generated and Luchs' invention is not necessarily concerned with events occurring after contract generation. However, Luchs actually does concern himself with events that occur after the generation of a contract. Specifically, Luchs teaches displaying an application (i.e. contract) for the purpose of approval/disapproval (col 2, ln 43-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Luchs with Hoyt, arriving at a more flexible contract generation system that is easier for users to use. It also would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shirley with Luchs and Hoyt, arriving at a contract generation system that maintains the general document construction method but provides a user with greater customization of documents and more expands on the supplemental contract-associated information provided by Hoyt."

In response to the preceding argument by the Examiner in "Response to Arguments", Applicants respectfully contend that Luchs, col. 2, lines 43-46 does not teach "displaying an application (i.e. contract) for the purpose of approval/disapproval" as alleged by the Examiner. Rather, Luchs, col. 2, lines 43-46 teaches a reinstatement file to facilitate entry of a reinstatement

order. Importantly, the reinstatement mechanism disclosed in Luchs, col. 2, lines 43-46 is simple and apparently works without the need to add the unnecessary complexity of Shirley's tracking dates. Thus it is not obvious to modify Luchs with Shirley's tracking dates.

Fifth Example

As a fifth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt et al. and in further view of Shirley 1, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "a tracker tool coupled to said entry tool and said document assembler for processing key date reminders and approvals into tracking data" (claim 1); "processing key date reminders and approvals into tracking data" (claim 7); and "fourth program instruction means for processing key date reminders and approvals into tracking data" (claim 13). While the Examiner has made arguments relating to the storing of tracking data and the tracking of dates, the Examiner has made not made any argument relating to **processing** key date reminders and approvals **into tracking data**" (emphasis added), as required by claims 1, 7, and 13.

Based on the preceding fifth example, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 1, 7, and 13.

Summary

Based on the preceding arguments of the first, second, third, fourth, and fifth examples, Applicants respectfully maintain that claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley, and that claims 1, 7, and 13 are in condition for allowance. Since claims 2-6 depend from claim 1, Applicants contend that claims 2-6 are

likewise in condition for allowance. Since claims 9-12 depend from claim 7, Applicants contend that claims 9-12 are likewise in condition for allowance. Since claims 14-21 depend from claim 13, Applicants contend that claims 14-21 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

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